

## **I. Restriction Requirement**

In the Office Action, the Examiner requires restriction between the following groups of claims:

Group I - Claims 42-85, drawn to a cosmetic composition;

Group II - Claims 86-98, drawn to a process for preparing a composition for making up keratin fibers;

Group III - Claims 99-118, drawn to a process for preparing a composition for making up keratin fibers;

Group IV - Claims 119-120, drawn to a process for making up keratin fibers;

See Office Action at 2.

Applicants respectfully traverse the restriction requirement. However, to be fully responsive, Applicants elect, with traverse, the subject matter of Group I, comprising Claims 42-85, drawn to a cosmetic composition.

The instant application is a national stage filing under 35 U.S.C. § 371 and thus unity of invention practice applies to the application. The Examiner contends that:

Groups I-IV do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

. . . [t]he instant composition Claim 42 does not present a contribution over the prior art. Claim 42 lacks inventive step. Claim 42 is obvious over the combination of U.S. Patents 6,716,420 ('420) and 6,534,047 ('047). Patent '420 under examples teaches claimed wax which is present in an amount greater than 3% by weight and volatile oil (cyclopentasiloxane), and teaches at col. 14, ll 6-7 water content less than 10% by weight. However, patent '047 teaches mascara composition (cosmetic) with water content up to 20% by weight at col. 20, ll 20-24, and one of ordinary

skill in the art would prepare the composition of patent '420 and change the water content from less than 10% to 'up to 20%' taught by patent '047 in analogous compositions. As a result, as currently presented, the instant composition claim 42 does not share a special technical feature with the instant process of preparing the composition or process for making up keratin fibers and, as such, unity between the above Groups I-IV is broken.

See Office Action at 2-3.

Applicants respectfully disagree with the Office's analysis of U.S. Patent Nos. 6,716,420 and 6,534,047 and the conclusion that the patents render obvious the claimed invention. Applicants reserve any further response until the issuance of an official action directed towards the elected subject matter.

Applicants submit that the Examiner's restriction requirement is improper and should be withdrawn.

## **II. Election of Species**

In addition, the Examiner also requires Applicants to elect a single species (a wax) and identify the claims encompassing that species. The Examiner notes that the claims are deemed to correspond to the species listed above in the following manner: 60-68, 103, 106-108. The Examiner also notes that claims 42-59, 69-102, 104-105, and 107-120 are generic. See Office Action at 3.

The election of species requirement is respectfully traversed. However, to be fully responsive, Applicants provisionally elect, with traverse, carnauba wax, with claims 42-59 and 66-85 reading on the elected species, either literally or under the doctrine of equivalents.

Applicants respectfully traverse the election of species requirement on the basis that the Examiner has not shown that a serious burden exists to examine all of the alleged species. To make a proper requirement for an election of species, the Examiner must, *inter alia*, show that the search and examination of a claim would impose a serious burden on the Office because it embraces an unreasonable number of species M.P.E.P. § 803.02 (emphasis added). Here, the Examiner has provided no reasons or evidence on the record to substantiate the election of species requirement, let alone show examination of all the species would impose a serious burden.

Nevertheless, if the Examiner chooses to maintain the election of species requirements, Applicants respectfully remind the Examiner of the duty of rejoinder, and of the duty to expand the search to non-elected species after the elected species has been found to be allowable. See M.P.E.P. § 803.02 and 35 U.S.C. § 121. For at least these reasons, the election of species requirements are improper and should be withdrawn.

### **III. Conclusion**

In view of the foregoing election and remarks, Applicants respectfully request reconsideration and examination of the claims. Please grant any extensions of time

required to enter this response and charge any additional required fees to Deposit  
Account No. 06-0916.

Respectfully submitted,

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